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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/026,335

12/21/2001

Sivaram Pillarisetti

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04/17/2006

EXAMINER

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P.O. BOX 7037

ATLANTA, GA 30357-0037

ART UNIT

PAPER NUMBER

1644

DATE MAILED: 04/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/026,335

Applicant(s)

PILLARISSETTI ET AL.

Examiner

David A. Saunders, PhD

Art Unit

1644

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 20 March 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☒ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☒ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attached. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-6, 10-14 and 16-34.
Claim(s) withdrawn from consideration: 8, 9 and 16-26.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☒ Other: see attached.

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The proposed amendment would raise new issues requiring a further search. The amendment would broaden the claims by deletion of the Markush group of “determinants of inflammation” recited in every independent claim, so that measuring any “determinant of inflammation” would be encompassed. This would require a broader search than that previously conducted.

Furthermore, even if applicant had retained the recitation of the Markush group of “determinants of inflammation” and had overcome the grounds of rejection based upon Medford et al, there would be a requirement for further searching. The claims presented before final action were rejectable over Medford et al with respect to VCAM-1 as a “determinant of inflammation”; further searches would be required for all of the other recited Markush group members, except for TNF-alpha, which is the elected species.

Deletion of the Markush group of “determinants of inflammation” recited in every independent claim would require the examiner to consider whether new matter has been entered.

The amendment presents new claims 35-39 for consideration. The only claims to be cancelled by the amendment had been withdrawn from consideration.

The request for reconsideration will not be considered, because the arguments concerning prior art pertain only to the previously stated rejection over Medford et al; clearly, with the scope

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of the proposed claims being broadened, there can be prior art besides Medford et al that would need to be overcome.

Regarding the statement of the rejection over Medford et al as alternatively being under 102 or 103, the examiner notes that the statement was made under 103, in the event that applicant considers that Medford et al's screening method to have been implicitly suggested, rather than explicitly taught.

The information disclosure statement (IDS) filed on 3/20/06 fails to comply with 37 CFR 1.97(d) because it lacks a statement as specified in 37 CFR 1.97(e). It has been placed in the application file, but the information referred to therein has not been considered. It is further noted that applicant's request for reconsideration has made no mention of any reference listed in the IDS; therefore, the examiner finds no good reason for the consideration of any reference of this IDS, since no reference has been presented as evidence in order to buttress applicant's urgings in the request for reconsideration.

Any inquiry concerning this communication should be directed to David A. Saunders, PhD at telephone number 571-272-0849.

Typed 4/12/06 DAS

David A. Saunders
DAVID SAUNDERS
PRIMARY EXAMINER
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